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PATENT

GP-3723

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent application of:
Frank D'Aguanno : Group Art Unit:
3723

Serial No: 09/676,627 : Examiner:
Daniel G. Shanley

Filed: October 2, 2000

For: METHOD AND APPARATUS FOR
REMOVING A GOLF CLUB HEAD
FROM A GOLF CLUB SHAFT

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**REQUEST BY APPLICANT FOR INTERFERENCE
WITH UNITED STATES PATENT 6,336,263 UNDER 37 C.F.R. 1.607**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

TECHNOLOGY CENTER R3700

Applicant hereby requests institution of an interference proceeding between the instant application and United States patent 6,336,263 issued in the name of Richard M. Weiss and Lou Gibson on 8 January 2002 based on application 09/499,367 filed 7 February 2000.

A proposed count is set forth in Attachment 1 hereto.

Claim 1 in United States patent 6,336,263 corresponds identically to the proposed count.

Claim 24, added to the instant application in a paper dated 20 October 2003 and currently pending in the application, corresponds identically to the proposed count. This identity was noted in applicant's paper dated 17 December 2003 submitted in connection with this application.

Claim 3, submitted as a part of this application when originally filed on 20 October 2000, corresponds substantially to the proposed count.

With respect to the requirement of 37 CFR 1.607(a)(5) for applying, to the disclosure of the application, the terms of any application claim identified as corresponding to the count and not previously in the application, applicant submits herewith Attachments 2, 3 and 4 which present comparisons, in various formats, of the proposed count (and hence applicant's newly added claim 24) to the language in applicant's specification, including the numbers corresponding to particular items of structure disclosed in applicant's specification and the location of applicant's specification where the language defining the structure and the item numbers may be found.

Specifically, Attachment 2 sets forth the proposed count (and hence applicant's claim 24) with the corresponding language and item numbers from the specification of applicant's application inserted into the text of the proposed count parenthetically and in italics to assist the examiner in identifying the insertions.

Attachment 3 goes one step further and provides item numbers, from applicant's specification, for all of the structural parts recited in the proposed count. Item numbers

are for the corresponding structure disclosed in applicant's specification. Additionally, in Attachment 3 the location in applicant's specification where each of those item numbers is initially identified and discussed, is set forth with the page number and line number of applicant's specification being provided. Attachment 3 further includes the specific language used by applicant in applicant's specification to identify and discuss the particular structure of interest where that language is presented in italics and parenthetically in the same manner as Attachment 2.

Attachment 4 again presents the proposed count, and hence applicant's claim 24, and includes applicant's item numbers for the structure defined by the proposed count and the locations in which those item numbers may be found in applicant's specification. For clarity, Attachment 4 does not include particular wording applicant used to describe the corresponding structure.

Respecting the requirement under 37 CFR 1.607(6) for an explanation of how the requirements of 35 USC 135(b) are met if the claims presented and identified as corresponding to the proposed count were not present in the application until more than one year after the issue date of the patent, applicant respectfully submits that claim 3, which has been pending in the application since the application was filed on 2 October 2000, substantially corresponds to the count proposed herein (and also substantially corresponds to applicant's claim 24, which applicant has identified as being identical to the proposed count). Applicant believes claims 3 and 24, while not being identical, are sufficiently close that if these claims were presented in separate but related applications, a terminal disclaimer to overcome a double patenting obviousness-type rejection might be required for the later-to-issue application.

In support of applicant's position on the substantial identity of original claim 3 to the proposed count, Attachment 5 to this paper presents the proposed count vis-à-vis the language of original claim 3 in application serial number 09/676,627 as that application was filed. Even the most cursory examination of Attachment 5 quickly reveals that there is substantial similarity, if not essential identity, as between the structure recited in original claim 3, which has been pending in application in serial number 09/676,627 since the application was filed (which was well before the issue date of United States patent 6,336,263 with which interference is respectfully solicited), and the structure defined by the proposed count.

Applicant respectfully notes that as clearly shown in Attachment 5, the structure recited in applicant's original claim 3 finds essentially identical correspondence in the proposed count. Indeed, while applicant selected somewhat different wording, for example choosing to refer to the jaws which hold the golf club shaft as the club head is removed as "a clamping mechanism", as contrasted to a "gripping member" (which is the language selected by the '263 patentee to describe the same structure), the essential correspondence between the proposed count and claim 3 is manifest. Moreover, when one compares the drawings of United States patent 6,336,263 to the drawings of the instant application, the identity of the subject matter claimed by applicant in claim 3 and the count becomes crystal clear. Figure 1 of U.S. 6,336,263 differs from Figure 1 of applicant's drawings essentially only by having the structure reversed in that the turret of '263 appears on the left hand side of the drawing in Figure 1 while applicant's turret appears at the right hand side of applicant's Figure 1. Similarly, the hydraulic piston-cylinder arrangement of '263 appears at the right hand

side of Figure 1 in '263 whereas the hydraulic piston-cylinder arrangement appears at the left hand side of applicant's Figure 1. Similar mirror images run throughout the drawings.

Applicant respectfully further notes as regards the requirement of 35 USC 135(b) and claim 3 vis-à-vis the proposed count and hence vis-à-vis claim 1 of U.S. patent 6,336,263, there can be no doubt that applicant, through claim 3, was claiming and continues to claim substantially the invention defined by claim 1 of U.S. 6,336,263. Both claim 1 of '263 and applicant's claim 3 are directed to a device for separating a golf club head from a golf club shaft. Both claims involve a device for holding the golf club shaft. Both claims call for such a holding device to be a gripping or clamping device and envision mechanically securing a golf club shaft in place. Both claims recite a device for separating the golf club head from the golf club shaft including a portion for engaging the golf club shaft and contacting the golf club head in order to urge the golf club head off the shaft once separating is actuated. Both claims call for actuating devices and both applications disclose a hydraulic piston to perform the actuating function to move the separating member, namely a turret as disclosed both in '263 and in the instant application, to push the golf club head off the golf club shaft when the turret is moved by the actuating device, namely the hydraulic piston. While the words of the claims may differ slightly, the claims are directed to substantially the same invention. Thus applicant has been asserting entitlement to a patent claim directed to substantially the same invention as claim 1 of '263 since 2 October 2000, the date applicant's application was filed, which is well before '263 issued.

Case law supports declaration of an interference in this situation:

In order to come within the exception of Rule 94 (now 35 U.S.C. 135(b)) one must have been claiming or asserting a claim or claims the same as, or for **substantially the same subject matter** as the claim or claims of the issued patent. *In re Frey*, 182 F.2d 184, 86 USPQ 99 (CCPA 1950)(emphasis supplied)

In evaluating whether applicant in claim 3 has been claiming substantially the invention defined by claim 1 of U.S. 6,336,263, immaterial limitations if any are there, in applicant's claim 3 may and should be disregarded. The issue is whether applicant has been claiming essentially the same invention, namely the same subject matter, as that defined by claim 1 of '263. When applicant's claim 3 is considered, it is appropriate to look at the **disclosure** of applicant's application and at the **disclosure** of '263:

The rule that every limitation of an interference count must be considered material, which rule is applied in determining the right to make the count and priority of invention, is not controlling on the question of estoppel under 35 U.S.C. 135. In the latter situation, the question as to the materiality of limitations is to be considered on its merits, and **limitations found to be immaterial may be disregarded.**

...
The determination as to whether the counts are supported by the disclosure of the Williams' application involves a consideration of the same limitations that have been discussed above, but from a different viewpoint. Here each limitation must be regarded as material, and **they are to be compared with the disclosure of the application** rather than with what was claimed in it before the counts were copied from the Rieser patent. *Rieser v. Williams*, 255 F.2d 419, 118 USPQ 96 (CCPA 1958) (emphasis supplied)

When the disclosures are compared and the claims are considered in light of the disclosures, there can be no doubt that applicant was and is claiming the subject matter defined by claim 1 of '263. This being the case, interference is appropriate and should be declared:

The rule that every express limitation must be considered material, which is applied in determining the right of a party to make a count

of an interference, is not applicable in determining whether claims are directed to substantially the same subject matter within the meaning of 35 U.S.C. § 135. In the latter situation it is necessary to distinguish between those limitations **which relate to the essence of the claimed subject matter** and those which do not. *Stalego v. Heymes*, 263 F.2d 334, 120 USPQ 473 (CCPA 1959)(emphasis supplied)

Applicant respectfully submits that when all of the foregoing is considered and the attachments hereto are studied carefully, is manifestly clear that there is interference between claim 1 of United States patent 6,336,263 and, at a minimum, applicant's claims 3 and 24. Accordingly, applicant respectfully solicits the declaration of an interference between applicant's application and United States patent 6,336,263, especially in light of the fact that applicant's application as filed was a continuation-in-part of earlier application serial number 09/427,461 filed 22 October 1999 which in turn claimed the benefit of provisional application 60/106,223 filed 30 October 1998.

Accordingly, applicant again requests a declaration of interference between the instant application and United States patent 6,336,263.

To the extent there are any additional fees required in connection with the receipt, acceptance and/or consideration of this paper and/or any accompanying papers

submitted herewith, please charge all such fees to Deposit Account 50-1943.

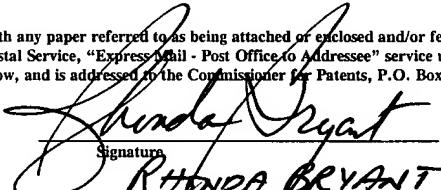
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Certificate of Mailing Under 37 C.F.R. 1.10	
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I hereby certify that this paper, along with any paper referred to as being attached or enclosed and/or fee is being deposited with the United States Postal Service, "Express Mail - Post Office to Addressee" service under 37 C.F.R. 1.10, on the date indicated below, and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
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Attachment 1 -- Proposed Count

A separation apparatus for separating a club head from a club shaft to which the club head is attached comprising:

- a. a movable gripping member for engaging and holding the club shaft at a first position spaced from the club head, said gripping member being mounted on a base and cooperating with a portion of said base to define a gripping area for the club shaft.
- b. a separation member mounted on said base for translation toward and away from said base in a direction substantially parallel to the longitudinal axis of a club shaft gripped by said gripping member and said portion of said base, said separation member including a club shaft engaging portion for engaging the club shaft in a closely interfitting manner at a second position spaced from said first position and during said translation for engaging the club head.
- c. an actuation device for effecting said translation of said separation member away from said base to effect separation of the club head from the club shaft.

**Attachment 2 -- Proposed Count (and Applicant's Claim 24) vis-à-vis
Language and Item Numbers from Specification of 09/676,627 as
Filed**

A separation apparatus for separating a club head from a club shaft to which the club head is attached comprising:

- a. a movable gripping member (*clamping mechanism 50, 54, 56, 58, 59*) for engaging and holding the club shaft at a first position spaced from the club head, said gripping member (*clamping mechanism 50, 54, 56, 58, 59*) being mounted on a base (*frame 20*) and cooperating with a portion of said base (*frame 20*) to define a gripping area for the club shaft;
- b. a separation member (*turret 46*) mounted on said base (*frame 20*) for translation toward and away from said base (*frame 20*) in a direction substantially parallel to the longitudinal axis of a club shaft gripped by said gripping member (*clamping mechanism 50, 54, 56, 58, 59*) and said portion of said base (*frame 20*), said separation member (*turret 46*) including a club shaft engaging portion for engaging the club shaft in a closely interfitting manner at a second position spaced from said first position and during said translation for engaging the club head; and
- c. an actuation device (*hydraulic piston 32*) for effecting said translation of said separation member (*turret 46*) away from said base (*frame 20*) to effect separation of the club head from the club shaft.

**Attachment 3 -- Proposed Count (and hence Applicant's Claim 24) vis-à-vis
Language, Item Numbers and Location Where Found in
Specification of 09/676,627**

A separation apparatus (item 10--pg. 6, ln. 11) for separating a club head (item 105--pg 6, ln. 14) from a club shaft (item 102--pg.6, ln. 13) to which the club head (item 104--pg. 6 , ln. 14) is attached comprising:

- a. a movable gripping member (*clamping mechanism*--items 50, 54, 56, 58, 59--pg.6, ln. 12 and pg. 8 , ln. 3-6) for engaging and holding the club shaft (item 102--pg.6, ln. 13) at a first position spaced from the club head (item 104--pg. 6, ln. 14), said gripping member (*clamping mechanism*--items 50, 54, 56, 58, 59--pg.6, ln. 12 and pg. 8 , ln. 3-6) being mounted on a base (*frame*--item 20--pg. 6, ln. 15) and cooperating with a portion of said base (*frame*--item 20--pg. 6, ln. 15) to define a gripping area for the club shaft (item 102--pg. 6, ln. 13);
- b. a separation member (*turret*--item 46--pg. 7, ln. 5) mounted on said base (*frame*--item 20--pg. 6, ln. 15) for translation toward and away from said base (*frame*--item 20--pg. 6, ln. 15) in a direction substantially parallel to the longitudinal axis of a club shaft (item 102--pg. 6, ln. 13) gripped by said gripping member (*clamping mechanism*--items 50, 54, 56, 58, 59--pg.6, ln. 12 and pg. 8 , ln. 3-6) and said portion of said base (*frame*--item 20--pg. 6, ln. 15), said separation member (*turret*--item 46--pg. 7, ln. 5) including a club shaft engaging portion for engaging the club shaft (item 102--pg.6,

ln. 13) in a closely interfitting manner at a second position spaced from said first position and during said translation for engaging the club head (item 104--pg. 6, ln. 14); and

c. an actuation device (*hydraulic piston*--item 3 --pg.6, ln. 20) for effecting said translation of said separation member (*turret*--item 46--pg. 7, ln. 5) away from said base (*frame*--item 20--pg. 6, ln. 15) to effect separation of the club head (item 104--pg. 6, ln. 14) from the club shaft (item 102--pg.6, ln. 13).

**Attachment 4 -- Proposed Count (and hence Applicant's Claim 24) vis-à-vis
Item Numbers and Location Where Corresponding Structure is
Found in the Specification of 09/676,627**

A separation apparatus (item 10--pg. 6, ln. 11) for separating a club head (item 105--pg 6, ln. 14) from a club shaft (item 102--pg.6, ln. 13) to which the club head (item 104--pg. 6 , ln. 14) is attached comprising:

- a. a movable gripping member (items 50, 54, 56, 58, 59--pg.6, ln. 12 and pg. 8 , ln. 3-6) for engaging and holding the club shaft (item 102--pg.6, ln. 13) at a first position spaced from the club head (item 104--pg. 6, ln. 14), said gripping member (items 50, 54, 56, 58, 59--pg.6, ln. 12 and pg. 8 , ln. 3-6) being mounted on a base (item 20--pg. 6, ln. 15) and cooperating with a portion of said base (item 20--pg. 6, ln. 15) to define a gripping area for the club shaft (item 102--pg. 6, ln. 13);
- b. a separation member (item 46--pg. 7, ln. 5) mounted on said base (item 20--pg. 6, ln. 15) for translation toward and away from said base (item 20--pg. 6, ln. 15) in a direction substantially parallel to the longitudinal axis of a club shaft (item 102--pg. 6, ln. 13) gripped by said gripping member (items 50, 54, 56, 58, 59--pg.6, ln. 12 and pg. 8 , ln. 3-6) and said portion of said base (item 20--pg. 6, ln. 15), said separation member (item 46--pg. 7, ln. 5) including a club shaft engaging portion for engaging the club shaft (item 102--pg.6, ln. 13) in a closely interfitting manner at a second

position spaced from said first position and during said translation for engaging the club head (item 104--pg. 6, ln. 14); and

c. an actuation device (item 3 --pg.6, ln. 20) for effecting said translation of said separation member (item 46--pg. 7, ln. 5) away from said base (item 20--pg. 6, ln. 15) to effect separation of the club head (item 104--pg. 6, ln. 14) from the club shaft (item 102--pg.6, ln. 13).

Attachment 5 -- The Substantial Identity of the Proposed Count and Claim 3
Originally in 09/676,627 as Filed

A separation apparatus for separating a club head from a club shaft to which the club head is attached comprising:

- a. a movable gripping member (*a clamping mechanism*) for engaging and holding the club shaft at a first position spaced from the club head (*connected to the frame for securing a golf club*), said gripping member being mounted on a base and cooperating with a portion of said base to define a gripping area for the club shaft;
- b. a separation member (*a turret having a smaller diameter portion and a larger diameter portion, the smaller diameter portion inserted in the open end of (the) a hollow shaft and abutting the second end of (the) a spring, the larger diameter portion being external to the shaft and having a slot designed to engage the shaft of the golf club while abutting the head of the golf club*) mounted on said base for translation toward and away from said base in a direction substantially parallel to the longitudinal axis of a club shaft gripped by said gripping member and said portion of said base, said separation member (*turret*) including a club shaft engaging portion for engaging the club shaft in a closely interfitting manner at a second position spaced from said first position and during said translation for engaging the club head; and

- c. an actuation device (*a hydraulic piston, a one piece hollow shaft having an open end and a closed end, the closed end connected to the distal end of the piston, and a spring having a first end and a second end, the spring residing within the hollow shaft with the first end abutting the closed end of the hollow shaft*) for effecting said translation of said separation member away from said base to effect separation of the club head from the club shaft.